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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,055	02/07/2001	Yuichi Asami	Q62904	7352

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EXAMINER

SAGER, MARK ALAN

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,055

Applicant(s)

ASAMI ET AL.

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9,11,12,14,15,17-25,27,29 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,11,12,14,15,17-25,27,29 and 31-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/15/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 19-20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The device/method as claimed is interpreted to be a signal (for distribution of a program) and thus is non-statutory since a signal, per se, is non-statutory subject matter due to not having any tangible, physical structure, not performing any useful, concrete or tangible result or does not form a tangible physical article or some form of matter (i.e. lacks physical characteristics). However, subject matter may be patentable if coupled with or combined with statutory physical structure to produce a useful, concrete and tangible result. Alternatively, the program is not stored on a computer readable media and thus is non-statutory subject matter since the invention as claimed is deemed functional descriptive material that at least is not stored/recorded/encoded on a computer readable media, its functional descriptive material is not interrelated to computer readable media to impart its functionality. It is noted that application presently includes claims of a storage medium storing a program, but does not include a program stored/recorded/encoded on a storage media. See *State Street*, 149 F.3d at 1374-1375, 47 USPQ 2d at 1602. *In re Wamerdam*, F.3d at 1260-61, 31 USPQ2d at 1760. *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). See *AT&T Corp. V. Excel Comm. Inc.*, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). Also, the PTO web site at <http://www.uspto.gov/web/patents/guides.htm> provides guidance for claiming inventions relating to program code in Examination Guidelines for Computer-Related Inventions & Training Materials, Final Version.

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3. Claim 14-15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. First, it is noted that although the specification discloses performance of a series of acts that appear statutory, the holding here is regarding the scope of claimed invention. Second, it is noted that 'executable during automated game play' is preamble language that fails to breath life and meaning into the claims since it is not 'essential to point out the invention defined by the claim'. *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951). Further, the language does not limit any structure of the claimed device at least since no structure is present. *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). Finally, alternatively, the language recites an intended use of structure where the claim body does not depend on the preamble for completeness such that the structural limitations stand alone (if structure is 'read into the claim'). *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). Thus, the preamble language 'executable during automated game play' is not limiting to claimed invention. However, the language is considered herein for the breadth of the invention as a whole herein.

Regarding the claimed invention being non-statutory, the method, as best understood, does not fall within the technological arts and is considered to be either an abstract idea or a signal/wave form. First, a method (e.g. process) is an act or a series of act, performed upon the subject matter to be transformed and reduced to a different state or thing as stated by Mr. Justice Bradley on page 787 of U. S. Supreme Court case *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1876). Also, *Corning v. Burden*, 15 How. 252, 267-268 (1853). Thus, the Court has defined statutory process as requiring treatment of materials or things to produce a particular result, wherein such treatment transforms and reduces the subject matter to a different state or thing. In this case, the claimed series of acts does not perform upon any subject matter to be transformed

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or does not reduce subject matter to a different state or thing. As claimed the invention shows a series of steps that are grounded in the abstract idea of outputting music portions in music output steps requiring at least an original music output and a connection music output without aid of any form of technology or structure. This appears to be a signal (incorporate above discussion regarding signal herein for signal). Also, the claimed invention of cited claims does not appear to require any structure to perform the acts and only requires music to be output. For instance in the broadest interpretation of claimed invention, a person singing during game play (although 'executable during automated game play' is preamble language that fails to breath life and meaning to the claim, it is treated herein, sic) where first music is first verse, second music is second verse and connection music is chorus or original music is any verse and connection music is chorus. Thus, scope of claimed invention is out put of music such as from a player singing, whistling, or even humming a tune, melody, or song during game play. It is also noted that the musical output does not in any manner need to correlate or form any relationship to game play so as to be synchronized with game play or correspond to game play, as claimed. Further, the invention, as best understood, contains no practical application so as to lack providing a useful, concrete and tangible result. See *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed Cir 1998). In this case, the method of music output provides no concrete tangible or useful result, as claimed, since a player, during automated game play, playing an air guitar/drum or humming or whistling to a melody in the player's head/mind (or to a song broadcast over radio) while playing meets this claim. The player's output of music (which is what meets the claim language) fails to provide a useful, concrete or tangible result. Such form is not statutory subject matter. See *State Street*, 149 F.3d

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at 1374-1375, 47 USPQ 2d at 1602. *In re Wamerdam*, F.3d at 1260-61, 31 USPQ2d at 1760. *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). See *AT&T Corp. V. Excel Comm. Inc.*, 50 USPQ2d 1447, 1452 (Fed Cir 1999). Also, see PTO web site cited above.

Alternatively, if claimed invention is a stored program method, the invention, as claimed, is non-statutory since the program is not stored on a computer readable media and thus is non-statutory subject matter since the invention as claimed is deemed functional descriptive material that at least is not stored/recorded/encoded on a computer readable media so that its functional descriptive material is not interrelated to computer readable media to impart its functionality. It is noted that application presently includes claims of a storage medium storing a program, but does not include a program stored/recorded/encoded on a storage media. Essentially, the storing of code on a memory medium is non-statutory due to the non-functional descriptive material is not enabled in conjunction with a processor/computer and thus lacks producing a concrete, tangible or useful result therefrom.

Claim Objections

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Applicant is advised that should claim 4,6 be found allowable, claim 33,35 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an

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application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claim 34 is also similar to claim 5.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claim 1, 8, 14-15, 17-18, 25, 27, 29,31-32, 36 is rejected under 35 U.S.C. 102(a) as being anticipated by either Yamaha Corp (JP 11-338468) or Taito Corp (JP 11-2119191). As best understood, see translation of notice of rejection of Japanese application No. 2000-029841.

Also, although Japanese patent rules do not protect method or programs, Yamaha or Taito each disclose methods or device using programs to control insertion of a bridge based on timing.

8. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Taito Corp (JP 10-222376). As best understood, see translation of notice of rejection of Japanese application No. 2000-029841. Also, although Japanese patent rules do not protect method or programs, Taito discloses a system for distributing game and program.

Claim Rejections - 35 USC § 103

9. Claim 2-3, 11-12 rejected under 35 U.S.C. 103(a) as being unpatentable over either Yamaha Corp (JP 11-338468) or Taito Corp (JP 11-2119191) each in view of Yamaha Corp (JP 9-230880, aka Sone). As best understood, see translation of notice of rejection of Japanese

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application No. 2000-029841. Yamaha Corp (JP 11-338468) or Taito Corp (JP 11-2119191)

each discloses method or device teaching claimed invention (supra) except cross fading.

However, cross fading between sound output a portion based on programming is known as taught by Yamaha (aka Sone). Therefore, it would have been obvious to an artisan at a time prior to the invention to add cross-fading as claimed, as taught by Yamaha to either Yamaha's method or Taito's system to link a plurality of output pieces smoothly.

10. Claim 4-6, 9, 21-23, 33-35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaha Corp (JP 11-338468) or Taito Corp (JP 11-2119191) each in view of either Yamaha Corp (JP 9-230880, aka Sone) or Roland Corp (JP 8-115084) or Yamaha Corp (JP 2000-035785). As best understood, see translation of notice of rejection of Japanese application No. 2000-029841. Yamaha Corp (JP 11-338468) or Taito Corp (JP 11-2119191) each disclose method or device teaching claimed invention (supra) except control change which changes gradually on basis of tempo of preceding and subsequent pieces of sound output. Yamaha Corp (JP 9-230880, aka Sone) or Roland Corp (JP 8-115084) or Yamaha Corp (JP 2000-035785) each disclose a device or method to perform a control change which changes gradually on basis of tempo of preceding and subsequent pieces of sound output so as to smoothly blend sound output. Therefore, it would have been obvious to an artisan at a time prior to the invention to add perform a control change which changes gradually on basis of tempo of preceding and subsequent pieces of sound output so as to adjust tempo of bridge with adjoining music, as claimed, as suggested by either Yamaha Corp (JP 9-230880, aka Sone) or Roland Corp (JP 8-115084) or Yamaha Corp (JP 2000-035785) to either Yamaha's method or Taito's system to link a plurality of output pieces smoothly.

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11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Yamaha Corp (JP 11-338468) or Taito Corp (JP 11-2119191) each in view of either Yamaha Corp (JP 9-230880, aka Sone) or Roland Corp (JP 8-115084) or Yamaha Corp (JP 2000-035785) as applied to claim 22 or 23 above, and further in view of Kyushu Hitachi Maxell, Ltd. (JP 52-17346).

Yamaha Corp (JP 11-338468) or Taito Corp (JP 11-2119191) each in view of either Yamaha Corp (JP 9-230880, aka Sone) or Roland Corp (JP 8-115084) or Yamaha Corp (JP 2000-035785) discloses claimed invention except random. However, randomizing sound output is known as taught by Kyushu Hitachi Maxell, Ltd. so the device does not generate weariness and high game performance can be obtained. Therefore, it would have been obvious to an artisan at a time prior to the invention to add random, as claimed, as taught by Kyushu Hitachi Maxell, Ltd to either Yamaha Corp (JP 11-338468) or Taito Corp (JP 11-2119191) each in view of either Yamaha Corp (JP 9-230880, aka Sone) or Roland Corp (JP 8-115084) or Yamaha Corp (JP 2000-035785) so the device does not generate weariness and high game performance can be obtained.

Response to Arguments

12. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Regarding Applicants request for withdrawal of finality, such request is rendered moot with filing of RCE.

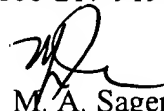
Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. A. Sager
Primary Examiner
Art Unit 3714

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